

C. REMARKS

This Reply is in response to the Office Action mailed on April 26, 2006 in which claims 1-10, 12-14 and 51-64 were rejected and claim 11 was objected to. Claims 1-14 and 51-64 are presented by the Applicants for reconsideration and allowance.

1. REJECTION OF CLAIMS 1-3, 5, 7, 9, 10 AND 51-64 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN

Section 2 of the Office Action rejected claims 1-3, 5, 7, 9, 10 and 51-64 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* (U.S. Patent No. 5,570,882) in view of *Martin* (U.S. Patent No. 4,570,931). Claim 1 is an independent claim and claims 2, 3, 5, 7, 9, 10 and 51-64 depend from claim 1.

Applicants maintain their position stated in the Amendment filed on February 23, 2006. Applicants respectfully submit that claims 1-3, 5, 7, 9, 10 and 51-64 are non-obvious and patentable over *Horkan* and *Martin*, either alone or in combination, because there is no suggestion to combine these references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (*citing In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

Horkan and *Martin* not only lack a suggestion to combine, but *Horkan* actually *teaches away* from a combination with *Martin*. A reference may be said to teach away when a person of ordinary skill, upon reading the reference would be discouraged, or led in a direction divergent, from the path that was taken by the applicant. *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (*citing In re Gurley*, 27 F.3d 551, 552-53 (Fed. Cir. 1994)). "[A] reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought." *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004). *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005). "[A]n applicant may rebut a *prima facie* case of

obviousness by showing that the prior art *teaches away* from the claimed invention *in any material respect*.” *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003) (*emphasis added*), *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005).

Horkan seeks a high level of engagement between the gloved fingertips of the user and the lacing of a modified football, and exclusively teaches that this high level of engagement occur *only* at and between the Velcro® patched fingertips of the gloved user and the lacing of the training football having corresponding Velcro® material. *Horkan* also teaches that the engagement level between the remaining surfaces of the training football and the remaining surfaces of the corresponding gloves be significantly lower to ensure that proper gripping of the training football by the young football player occurs *only* at the connection of the gloved fingertips of the user and the lacing of the training football.

Horkan specifically teaches away from improving the grippability of the lacing in general. Rather, *Horkan* specifically teaches a high level of grippability *only* between the gloved fingertips of the user and the lacing of the training football, and NOT the lacing of the football with other locations of the gloved user’s hands.

In the background of the invention, *Horkan* discusses this exact point. *Horkan* explains that the prior art applied Velcro® strips to the outer surface of a football for interaction with a player wearing cotton gloves. *Horkan* specifically states that this prior art arrangement does not meet the intent of his invention. *Horkan* emphasizes that such prior art arrangements do not enhance a proper throwing of a football, and do not assure that the ball is properly grasped only at the lacing. *Horkan* teaches away from increased grippability of the training football to the hands of a user, and from increased grippability in all locations of a user’s gloved hands, except for the fingertips of the gloved user and the lacing of the football. Increased grippability of a football and the user’s hands in general is undesirable and not intended under *Horkan*. *Horkan* also teaches away from use of the training football of his invention by an ungloved user.

Accordingly, *Horkan* teaches away from a combination with *Martin* and from the claimed invention. *Horkan* teaches away from increasing the grippability of the exposed surface of the lacing for contact directly with the user's hands, as required by the claimed invention. *Horkan* does not teach generally increasing the grippability of a football or of the lacing of a football. Rather, *Horkan* wishes to avoid generally increasing the grippability of the football and/or the laces to a user hands. *Horkan* teaches only increased grippability between the gloved fingertips of the user and the lacing of the training football. *Horkan*'s objective is to ensure proper hand positioning of the user to the training football so that the young player learns the correct hand position for throwing the training football.

The Abstract very clearly states *Horkan*'s objective. "The football is grasped by a user *wearing a glove* having Velcro® hook elements *only at the fingertips* thereof. The *restriction* of the Velcro® elements *to the football lacing and the fingertips of the glove* urges the user to grasp the football *only* at the laces so as to impart a proper spin thereto upon subsequent throwing." Abstract (*emphasis added*). *Horkan*'s objective teaches away from generally improving the grippability of the outer surface of the lacing to the hands of a user in general. As reiterated in the background of the invention, improving the contact between a training football and a gloved (or ungloved) user is undesirable. Rather, the improved contact or grippability must occur *only and exclusively* between the lacing and the fingertips of the gloved user.

I have invented a training aid in the form of *a modified football and glove*. The modified football utilizes lacing having one element of a Velcro® fastener combination thereon. *A flexible glove has* the complementary *mating elements* of Velcro® fastener combination *only at the fingertips* thereof. The use of the Velcro *only* on the laces *forces* the *gloved* user to properly grasp the football only at such laces.

Col. 1, lines 41-47 (*emphasis added*).

One of ordinary skill in the art, upon reading *Horkan*, would be discouraged and led in a direction divergent from the path that was taken by present Application. One of

ordinary skill in the art, upon reading *Horkan*, would quickly recognize that the line of development flowing from *Horkan*'s disclosure would be unproductive of the result sought in the present Application. As discussed above, *Horkan* teaches away from the claimed invention in many material respects.

Additionally, Applicants have shown that the frictional engagement between corresponding (mating) Velcro® materials is significantly higher than the engagement of Velcro® materials with other non-mating surfaces. In fact, Velcro® materials alone (when not used with corresponding, complementary or mating Velcro® materials) have coefficient of friction values that are significantly lower than commonly used game ball materials, such as artificial leather or natural leather. Therefore, *Horkan* does not in anyway teach increasing the grippability of the lacing of a football to the hands of a user. In fact, *Horkan* teaches the opposite. *Horkan* teaches away from the use of surfaces that are highly grippable when directly contacted by a user's hands as required by the claims.

If one were to combine the pebbled surface of the basketball of *Martin* to the lacing of the modified football of *Horkan*, the intent and objective of *Horkan* would be completely eliminated. Nothing would urge the young user's hands into the proper grasping position as taught and desired by *Horkan*. The interaction of the user's hands (at any location) would be no different than the user's fingertips, and interaction between a user's gloved hands (with Velcro® material positioned at the fingertips) and the lacing would not be enhanced. A grip of the ball to the young user would not be enhanced or improved only at the user's fingertips. Replacement of the Velcro® fasteners with the projections of *Martin* as suggested by Pages 6 and 7 of the Office Action would NOT accomplish the stated objectives of *Horkan*. Rather, the objectives of *Horkan* would be completely unfulfilled.

Further, neither *Horkan* nor *Martin*, alone or in combination, teach, suggest or disclose the combination of elements and limitations of independent claim 1. In particular, neither *Horkan* nor *Martin*, alone or in combination, teach, suggest or disclose a football

including a casing and an outwardly extending lacing, having an exposed surface, coupled to the casing, wherein at least a portion of the exposed surface of the lacing has a pebbled texture that is highly grippable when directly contacted by a user's hand. As described above, *Horkan* and *Martin* teach away from such a combination.

Neither *Horkan* nor *Martin* teach, disclose or suggest the football of claim 1, as amended. Accordingly, it is respectfully submitted that claim 1 overcomes the rejection based upon *Horkan* in view of *Martin*, and is believed to be in condition for allowance. It is also respectfully submitted that claims 2, 3, 5, 7, 9, 10 and 51-64, which depend from amended claim 1, are patentable over *Horkan* and/or *Martin* for at least the same reasons.

2. ***REJECTION OF CLAIMS 4, 8 AND 12 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND FEENEY***

Section 3 of the Office Action rejected claims 4, 8 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, and *Feeney* (U.S. Patent No. 6,283,881). Claims 4, 8 and 12 depend from independent claim 1. It is respectfully submitted that claims 4, 8 and 12 are patentable over *Horkan* in view of *Martin* and *Feeney* for at least the same reasons as discussed above with respect to independent claim 1. *Feeney*, like *Martin*, discloses a game ball, such as a basketball, including a plurality of panels having projections. The projections of *Feeney* are generally formed in the shape of closed loops. *Feeney*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1. *Feeney* does not teach, suggest or disclose football lacings and does not teach, suggest or disclose applying its projections onto the lacing of a football. In particular, *Feeney* does not teach, suggest or disclose a football including a casing and an outwardly extending lacing, having an exposed surface, coupled to the casing, wherein at least a portion of the exposed surface of the lacing has a pebbled texture that is highly grippable when directly contacted by a user's hand.

Horkan, Martin and Feeney, alone or in combination, do not teach, disclose or suggest the game ball of claim 1, as amended. Accordingly, it is respectfully submitted that claims 4, 8 and 12, which depend from claim 1, are patentable over *Horkan, Martin, and Feeney* for at least the same reasons.

3. ***REJECTION OF CLAIM 6 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND FINLEY***

Section 4 of the Office Action rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, and *Finley* (U.S. Patent No. 4,991,842). Claim 6 depends from independent claim 1. It is respectfully submitted that claim 6 is patentable over *Horkan* in view of *Martin* and *Finley* for at least the same reasons as discussed above relating to claim 1. *Finley* discloses a spherical basketball having a plurality of recesses formed on the exterior of the basketball and a network of interconnected ridges separating adjacent ridges. *Finley*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1. *Finley* does not teach, suggest or disclose lacings of a football and does not teach, suggest or disclose applying its plurality of recesses onto the lacing of a football. In particular, *Finley* does not teach, suggest or disclose a football including a casing and an outwardly extending lacing, having an exposed surface, coupled to the casing, wherein at least a portion of the exposed surface of the lacing has a pebbled texture that is highly grippable when directly contacted by a user's hand.

Horkan, Martin and Finley, alone or in combination, do not teach, disclose or suggest the game ball of claim 1. Accordingly, it is respectfully submitted that claim 6, which depend from claim 1, is patentable over *Horkan, Martin, and Finley* for at least the same reasons.

4. ***REJECTION OF CLAIMS 1-3, 5, 7, 9, 10 AND 51-64 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND YANG***

Section 5 of the Office Action rejected claims 1-3, 5, 7, 9, 10 and 51-64 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin* and *Yang* (U.S. Patent No. 6,520,877). It is respectfully submitted that claim 6 is patentable over *Horkan* in view of *Martin* and *Yang* for at least the same reasons as discussed above in Section 1 of this Reply. *Yang* discloses a basketball having a carcass and a leather cover. The carcass includes a plurality of grooved partition ribs and the leather cover is multiple panels adhered to the outer surface of the carcass between the ribs. The leather cover has grains protruding from its outer surface. *Yang*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1. *Yang* does not teach, suggest or disclose lacings of a football and does not teach, suggest or disclose applying its plurality of ribs or grains to the lacing of a football. In particular, *Yang* does not teach, suggest or disclose a football including a casing and an outwardly extending lacing, having an exposed surface, coupled to the casing, wherein at least a portion of the exposed surface of the lacing has a pebbled texture that is highly grippable when directly contacted by a user's hand.

Horkan, *Martin* and *Yang*, alone or in combination, do not teach, disclose or suggest the game ball of claim 1. Accordingly, it is respectfully submitted that claim 1 overcomes the rejection based upon *Horkan* in view of *Martin* and *Yang*, and is believed to be in condition for allowance. It is also respectfully submitted that claims 2, 3, 5, 7, 9, 10 and 51-64, which depend from amended claim 1, are patentable over *Horkan*, *Martin* and/or *Yang* for at least the same reasons.

5. ***REJECTION OF CLAIMS 4, 8 AND 12 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN, YANG AND FEENEY***

Section 6 of the Office Action rejected claims 4, 8 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, *Yang* and *Feeney*. It is respectfully submitted that claims 4, 8 and 12 are patentable over *Horkan* in view of *Martin*,

Yang and *Feeney* for at least the same reasons as discussed above with respect to independent claim 1.

Horkan, Martin, Yang and *Feeney*, alone or in combination, do not teach, disclose or suggest the game ball of claim 1, as amended. Accordingly, it is respectfully submitted that claims 4, 8 and 12, which depend from claim 1, are patentable over *Horkan, Martin, Yang* and *Feeney* for at least the same reasons.

6. ***REJECTION OF CLAIM 6 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN, YANG AND FINLEY***

Section 7 of the Office Action rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin, Yang*, and *Finley*. It is respectfully submitted that claim 6 is patentable over *Horkan* in view of *Martin, Yang*, and *Finley* for at least the same reasons as discussed above relating to claim 1.

Horkan, Martin, Yang, and *Finley*, alone or in combination, do not teach, disclose or suggest the game ball of claim 1. Accordingly, it is respectfully submitted that claim 6, which depend from claim 1, is patentable over *Horkan, Martin, Yang*, and *Finley* for at least the same reasons.

7. ***REJECTION OF CLAIMS 1-3 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902 OR CLAIM 1 OF PATENT NO. 6,767,300***

Section 8.1. of the Office Action rejected claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300. With this Reply, Applicants submit two separate terminal disclaimers to obviate the double patenting rejection. In particular, Applicants submit two separate executed forms, USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902 and for U.S. Patent No. 6,767,300.

**8. REJECTION OF CLAIMS 4, 8 AND 12 UNDER THE JUDICIALLY
CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING
OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902 OR CLAIM 1 OF PATENT
NO. 6,767,300**

Section 8.2. of the Office Action rejected claims 4, 8 and 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300. As stated above, with this Reply, Applicants submit two separate terminal disclaimers to obviate the double patenting rejection for U.S. Patent No. 6,629,902 and for U.S. Patent No. 6,767,300.

**9. REJECTION OF CLAIMS 5, 7, 9, 10 AND 51-64 UNDER THE
JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE
PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902 OR CLAIM 1
OF PATENT NO. 6,767,300, EACH IN VIEW OF MARTIN**

Section 8.3. of the Office Action rejected claims 5, 7, 9, 10 and 51-64 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300, each in view of *Martin*. As stated above, with this Reply, Applicants submit two separate terminal disclaimers to obviate the double patenting rejection for U.S. Patent No. 6,629,902 and for U.S. Patent No. 6,767,300.

**10. REJECTION OF CLAIM 6 UNDER THE JUDICIALLY CREATED
DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3
OF U.S. PATENT NO. 6,629,902 OR CLAIM 1 OF PATENT NO. 6,767,300,
EACH IN VIEW OF FINLEY**

Section 8.4. of the Office Action rejected claim 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300, each in view of *Finley*. As stated above, with this Reply, Applicants submit two separate terminal disclaimers to obviate the double patenting rejection for U.S. Patent No. 6,629,902 and for U.S. Patent No. 6,767,300.

**11. REJECTION OF CLAIMS 13 AND 14 UNDER THE JUDICIALLY
CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING
OVER CLAIM 3 AND 5 OF U.S. PATENT NO. 6,629,902 IN VIEW OF
FEENEY**

Section 8.5. of the Office Action rejected claims 13 and 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 and 5 of U.S. Patent No. 6,629,902 in view of *Feeney*. As stated above, with this Reply, Applicants submit a separate terminal disclaimer to obviate the double patenting rejection for U.S. Patent No. 6,629,902.

12. ALLOWABLE SUBJECT MATTER

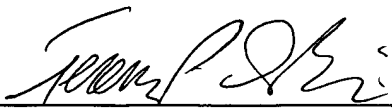
Applicants appreciate the Examiner's statement in Section 10 of the Office Action that claim 11 is allowable.

13. CONCLUSION

Applicants respectfully request reconsideration of claims 1-10, 12-14 and 51-64. Applicants believe that the present application is now in condition for allowance. The Examiner is invited to telephone the undersigned to discuss any issues in this case in order to advance the prosecution thereof.

Respectfully submitted,

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